

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

125525

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on _____

Signature _____

Typed or printed name _____

Application Number

09/802,163

Filed

March 8, 2001

First Named Inventor

Christopher Keith

Art Unit

3691

Examiner

Clement B. Graham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Kevan L. Morgan/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Kevan L. Morgan

Signature

Typed or printed name

☒ attorney or agent of record.
Registration number 42,015

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☐ attorney or agent acting under 37 CFR 1.34.

March 16, 2010

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	C. Keith	Attorney Docket No.:	125525
Application No.:	09/802163	Art Unit:	3696 / Confirmation No.: 1129
Filed:	March 8, 2001	Examiner:	C.B. Graham
Title:	AUTOMATED FIRST LOOK AT MARKET EVENTS		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Seattle, Washington 98101

March 16, 2010

TO THE COMMISSIONER FOR PATENTS:

Applicant respectfully requests review of the final Office Action mailed September 16, 2009. It is believed that clear error exists and that a pre-appeal brief request for review is proper.

Introduction

In the final Office Action, Claims 1-29 were rejected as allegedly being obvious over Serkin (U.S. Publ. No. 2002/0161687) in view of Madoff (U.S. Publ. No. 2001/0044767). This request for review focuses primarily on the rejection of independent Claim 4. Additional discussion of independent Claims 1, 8, 13, 18, 28, and 29, is provided thereafter.

Applicant submitted a Response After Final on January 15, 2010, and received an Advisory Action by facsimile on March 16, 2010, which maintained the claim rejections on the same grounds as in the final Office Action.

The elements recited in Claim 4 and the other independent claims are simply not taught or suggested by the combination of Serkin and Madoff. Therefore, a *prima facie* case of obviousness has not been established and the claim rejections should be withdrawn.

Claim 4

The method of Claim 4 includes, *inter alia*:

- "automatically . . . selecting a party to receive notification of a new contra-side best market price for a trade at the market in advance of other market participants,

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wherein the selected party is a market participant participating in a market with the other market participants, and wherein the selected party has provided a price for a side of the trade at the market"

- "automatically . . . notifying the selected party of the new contra-side best market price for the trade in advance of the other market participants"
- "automatically . . . measuring a predetermined time from when notification of the new contra-side best market price was sent to the selected party and, after the predetermined time has elapsed, notifying the other market participants of the new contra-side best market price."

The Office Action (page 3) asserted that Serkin teaches selecting a party to receive notification of a new contra-side best market price for a trade at the market in advance of other market participants. Applicant strongly disagrees. According to the abstract of Serkin, "[t]he system includes an order execution process that receives orders and matches orders against quotes posted in the system on a time priority basis." Nowhere does Serkin teach or suggest "*selecting a party to receive notification of a new contra-side best market price for a trade at the market in advance of other market participants*," as claimed in Claim 4. Madoff, for its part, does not overcome this deficiency of disclosure of Serkin.

The Office Action (page 3) conceded, and applicant agrees, that Serkin fails to teach "*notifying the selected party of the new contra-side best market price for the trade in advance of the other market participants*." The Office Action also conceded that Serkin fails to teach "*measuring a predetermined time from when notification of the new contra-side best market price was sent to the selected party and, after the predetermined time has elapsed, notifying the other market participants of the new contra-side best market price*." Nevertheless, the Office Action did not provide specific facts from Madoff that support the contention that Madoff overcomes the deficiencies of Serkin.

Madoff discloses a process that matches newly received orders with other orders in a conventional fashion. At paragraph [0055], lines 5-7, Madoff explains "the process 100 exposes 104 the order to the crowd, i.e., potential responders 14, via an electronic broadcast over the network systems mentioned above." In other words, according to Madoff, a received order is broadcast to all potential responders at the same time, as is done in conventional market systems.

The Office Action cited the abstract of Madoff and paragraphs [0006]-[0011] and paragraphs [0055]-0057] and [0062] of Madoff, but these portions of Madoff do not support the rejection of Claim 4. The process described by Madoff simply matches newly received orders with other orders in which the orders are broadcast to all of the market participants at the same time. In contrast with Madoff, the market according to Claim 4 instead "automatically...notif[ies] the selected party of the new contra-side best market price for the trade *in advance of the other market participants.*" (Emphasis added). See also Claim 8 in which "the trading party is given a first look at the new price before the other market participants."

In *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 U.S.P.Q.2d 1385, 1395-97 (2007), the Supreme Court indicated that the key to supporting any rejection under 35 U.S.C. § 103 is a clear articulation of the reason(s) why the claimed invention would have been obvious. See also M.P.E.P. § 2143. For reasons discussed herein, Serkin and Madoff do not disclose or suggest all of the elements of Claim 4, and therefore there is no combination of Serkin and Madoff that can render Claim 4 obvious. The rejection of Claim 4 should be withdrawn.

Claim 1

With respect to Claim 1, the Office Action (page 2) conceded, and applicant agrees, that Serkin fails to teach "*at the market participant's computer, receiving from the market a new contra-side best market price for the trade in advance of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at market participant's computer.*" The Office Action relied on Madoff as allegedly disclosing these elements of Claim 1. However, the reliance on Madoff is in error.

Madoff discloses a process that matches newly received orders with other orders in a conventional fashion. As explained at paragraph [0055] of Madoff, a received order is broadcast to all potential responders at the same time ("the process 100 exposes 104 the order to the crowd, i.e., potential responders 14, via an electronic broadcast over the network systems mentioned above").

In contrast, according to Claim 1 of the present application, a market participant (who, as claimed, is a "trading party") "receiv[es] from the market a new contra-side best market price for the trade *in advance* of the other market participants as a result of satisfying the market-related condition and only while the market-related condition is satisfied by the input received at market participant's computer." (Emphasis added.)

Because Serkin and Madoff do not disclose or suggest all of the elements of Claim 1, there is no combination of Serkin and Madoff that renders Claim 1 obvious.

Claims 8, 13, and 29

The rejection of Claims 8, 13, and 29 should be withdrawn at least for reasons similar to the reasons discussed above with respect to Claim 4. Claim 8 is directed to a system, Claim 13 is directed to a computer-accessible medium, and Claim 29 is directed to a computing device.

The Office Action (page 5) rejected Claim 8 as allegedly being unpatentable over Serkin and Madoff. Serkin teaches a market system that includes an internal execution process that "receives orders and matches orders against quotes posted in the system on a time priority basis." (See, e.g., the abstract of Serkin.) Serkin also teaches "an order match-off process that checks if a market participant identification associated with a received order matches a market participant identification representing a quote in the system that is at the best bid or best offer price in the system." Nevertheless, Serkin does not teach or suggest "select[ing] a party to receive notification of a new contra-side best market price for a trade at the market in advance of other market participants." Furthermore, the Office Action (page 5) conceded that Serkin does not teach "measur[ing] a predetermined time from when notification of a new contra-side best market price is sent to the selected party and, after the predetermined time has elapsed, to notify the other market participants of the new contra-side best market price," and instead relied on Madoff in this regard.

Madoff teaches a system that includes a server computer coupled to workstations for entering orders, predefined relative indications, and responses. The server computer executes a

server process that, for a first one of the orders, determines a match during an interval determined by the exposure time specified by the first order. See, e.g., the abstract of Madoff.

Inspection of the disclosure of Madoff however shows that Madoff does not teach or suggest "measur[ing] a predetermined time from when notification of a new contra-side best market price is sent to the selected party and, after the predetermined time has elapsed, to notify the other market participants of the new contra-side best market price." Madoff simply tries to match newly received orders with other orders in a conventional fashion. As noted earlier, orders received by the process 100 are exposed to all of the participants at the same time, as is done conventionally.

Absent specific facts from Serkin and Madoff supporting a prima facie case of obviousness, withdrawal of the rejection of Claims 8, 13, and 29 is warranted.

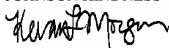
Claims 18 and 28

Applicant further submits that the rejection of Claims 18 and 28 should be withdrawn for at least reasons similar to the reasons discussed above with respect to Claim 1. As recited in Claim 18, the trading party is "*given a first look at the new price before the other market participants*," which is not disclosed by Serkin and Madoff.

Claim 28 recites a computer system and is written in means plus function format. As detailed in applicant's Response After Final, one example of an algorithm described in the specification for carrying out the claimed means in a computer system is described in relation to the flowchart of Figure 76. See, e.g., page 90, lines 19-27, of the application as filed. Withdrawal of the rejection of Claims 18 and 28 is merited.

Respectfully submitted,

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